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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

4143

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,956	Applicant(s) PARK ET AL.	
	Examiner NATHAN C. UBER	Art Unit 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 8, 13, 14 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 December 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the national stage entry filed on 14 October 2005.
2. Claims 1-22 are currently pending and have been examined.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "210" and "310" have both been used to designate *predetermined event*.
4. Figures 1 and 11 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
5. Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The abstract of the disclosure is objected to because it contains self evident clauses and legal phraseology, it is over the maximum word limit and it was not provided on a separate sheet. Correction is required. See MPEP § 608.01(b).
7. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.
8. The use of the trademark *Netscape* has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of

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trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

10. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).
11. Claims 8, 13, 14 and 18 include references to Claim 1 either as short-hand or because applicant intended to make claims 8, 13, 14 and 18 dependent on Claim 1. The reference is improper. For the purposes of this examination Examiner interpreted the references as impermissible short-hand and did not lend the references patentable weight. Applicant must remove these references to claim 1 or place the claims in proper dependent form.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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14. The claims are replete with limitations that lack antecedent basis. For example claim 1 recites the limitations *the received event, the searched type, the searched reference information, the information* and *the updated advertisement list information* all of which lack antecedent basis. Examiner suggests paying particular attention to the various types of *information* recited throughout the claims.
15. The claims are replete with indefinite terminology that is not commonly used in the art and not defined or sufficiently explained in the specification, specific examples are listed accompanied by Examiner's interpretation for the purposes of this examination. Claim 1 recites *judging*; Examiner interpreted this to mean categorizing. Claim 8 recites *guiding information data* and *confirmation response*. Examiner interpreted the terms to mean a link and confirming an action, respectively. Claim 9 recites *input counter value* which examiner interprets to mean a type of classification data. Claim 13 recites *access request*, which examiner interpreted to mean entering a URL in a browser.
16. Claims 6, 10, 17, 19 and 22 recite the limitation *more than one among*. This limitation is indefinite because one having ordinary skill in the art would not know how to avoid infringing these claims because one cannot know which limitations or which combinations of limitations applicant is claiming.

Claim Rejections - 35 USC § 101

17. 35 U.S.C. 101 reads as follows:
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
18. Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 18 recites *a recording medium*; however the claim does not recite any structure. Examiner interprets claim 18 to claim a computer program which is not statutory subject matter under 35 U.S.C. 101. Examiner suggests replacing *a recording medium* with "a

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computer-executable program tangibly embodied on a computer readable medium” because it complies with the statutory subject matter requirements 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. **Examiner’s Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
21. Claims 8, 10, 13-19, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Nam et al. (WO 02/07030 A1).

Claim 8:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for storing more than one keyword and advertisement information generated by the method according to claim 1 in response to the keyword* (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than *keyword*),
- *receiving an advertisement request that includes an advertisement keyword from a first sponsor* (see at least page 13, line 20-21),

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- *searching for advertisement information that corresponds to the advertisement keyword by referring to the keyword database (see at least page 3, line 26),*
- *processing the searched advertisement information and providing guiding information data to a web browser of the first sponsor (see at least page 8, line 23-24, link),*
- *receiving a confirmation response from the first sponsor, in which the confirmation response includes first advertisement data of the first sponsor (see at least page 12, line 30),*
- *recording, in a first advertisement database, the advertisement keyword and the first advertisement data that corresponds to the advertisement keyword (see at least page 3, line 20).*

Claim 10:

- *wherein the guiding information data includes more than one among information for the number of the generated advertisement files, information for the number of impressions of a web page that corresponds to the advertisement keyword, price information of the advertisement keyword (see at least page 16, line 20-21).*

Claims 13 and 14:

Nam, as shown, discloses the following limitations:

- *maintaining an advertisement database for storing more than one keyword and more than one advertisement data that corresponds to the keyword (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than keyword),*
- *receiving an access request from a user, in which the access request includes an advertisement file stored in a user’s terminal (see at least Figure 3, Item 304),*

- *extracting a keyword recorded in the received advertisement file (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),*
- *searching for the advertisement data that corresponds to the keyword by referring to the advertisement database (see at least page 3, line 26),*
- *processing the searched advertisement data and providing the same to a web browser of the user (see at least page 3, line 26-27),*
- *maintaining a keyword database for storing more than one keyword and advertisement information generated by the method according to claim 1 in response to the keyword (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than keyword),*
- *receiving an advertisement request that includes an advertisement keyword from a sponsor (see at least page 13, line 20-21),*
- *searching for advertisement information that corresponds to the advertisement keyword by referring to the keyword database (see at least page 3, line 26),*
- *processing the searched advertisement information and providing guiding information data to a web browser of the sponsor (see at least page 8, line 23-24, link),*
- *receiving a confirmation response from the sponsor, in which the confirmation response includes advertisement data of the sponsor (see at least page 12, line 30),*
- *recording, in an advertisement database, the advertisement keyword and the advertisement data that corresponds to the advertisement keyword (see at least page 3, line 20).*

Claim 15:

Nam, as shown, discloses the following limitations:

- *maintaining a second advertisement database for storing more than one of second advertisement data that corresponds to a predetermined keyword* (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than *keyword*),
- *maintaining a third advertisement database for storing more than one of third advertisement data* (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than *keyword*),
- *receiving a keyword from the user* (see at least page 11, lines 8-9),
- *searching for the second advertisement data that corresponds to the keyword by referring to the second advertisement database* (see at least page 3, line 26),
- *searching for the third advertisement data by referring to the third advertisement database* (see at least page 3, line 26),
- *constructing a user interface screen by arranging the advertisement data, the second advertisement data, and the third advertisement data according to a predetermined reference* (see at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),
- *providing the user interface screen to a web browser of the user reference* (see at least page 2, line 18, ads are displayed).

Claims 16 and 21:

Nam, as shown, discloses the following limitations:

- *the second advertisement data is general keyword advertisement data, and the third advertisement data is general banner advertisement data* (see at least page 8, line 13, banner advertisement).

Claims 17 and 22:

Nam, as shown, discloses the following limitations:

- *providing predetermined feedback information to the sponsor, in which the feedback information includes more than one among the number of times the advertisement is provided to the user, the number of times the user clicks on the advertisement, a time period the user visits the web page of the first sponsor, and the number of times the user visits the web page of the first sponsor after the advertisement is provided (see at least page 16, line 20-21).*

Claim 18:

Nam, as shown, discloses the following limitation:

- *a program for performing a method according claim 1 is recorded (see at least page 2, line 8, CGI program unit).*

Claim 19:

Nam, as shown, discloses the following limitations:

- *a keyword database for recording more than one keyword, type information of the keyword, predetermined reference information that corresponds to the type information, advertisement list information that corresponds to the keyword, in which the advertisement list information includes information for the number of the advertisement files that include the keyword (see at least Figure 1, Item 118),*
- *a communication part for receiving a predetermined event from a user (see at least Figure 1, Item 111),*
- *a processing part for recording a keyword that corresponds to the received event, for history data, searching for the type information of the keyword and the reference information that corresponds to the searched type information by referring to the keyword database, and judging whether the keyword is the*

interested field of the user according to the searched reference information (see at least Figure 1, Item 115),

- *an advertisement file preparing part for extracting the keyword judged to be the interested field of the user, and generating an advertisement file that includes the extracted keyword, in which the advertisement file includes more than one among a user's terminal number (PC ID), an identifying symbol of the user, and expiration date information of the advertisement file (see at least Figure 1, Item 116),*
- *an advertisement information generating part for updating information for the number of advertisement files in the advertisement list information stored in the keyword database, and generating advertisement information including the keyword and the updated advertisement list information (see at least Figure 1, Item 119),*
- *an advertisement database for storing more than one keyword and more than one advertisement data that corresponds to the keyword (see at least Figure 1, Item 118),*
- *an advertisement transmitting part for processing advertisement data that corresponds to the keyword included in the advertisement file by referring to the advertisement database, and providing the processed advertisement data to a web browser of the user (see at least Figure 1, Item 112),*
- *a storing part for storing history information about providing of the advertisement data (see at least Figure 1, Item 118),*
- *an analyzing part for providing predetermined feedback information to a sponsor who has registered the advertisement data, on the basis of the stored history information (see at least Figure 1, Item 116).*

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
24. Claims 1-7, 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02/07030 A1) in view of Cohn et al. (US 6,308,202 B1).

Claim 1:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for recording more than one keyword, type information of the keyword, predetermined reference information that corresponds to the type information, and advertisement list information that corresponds to the keyword, in which the advertisement list information includes information for the number of advertisement files including the keyword (see at least page 8, line 10-12, a database that may be indexed by “key” – note that this patent uses the phrase “key word” and “key” rather than keyword),*
- *receiving a predetermined event from a user (see at least Figure 3, Item 304),*

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- *recording a keyword that corresponds to the received event, for history data* (see at least page 3, line 20, storing characteristics of a site in a cookie)
- *searching for the type information of the keyword by referring to the keyword database* (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),
- *searching for the reference information that corresponds to the searched type information* (see at least page 3, line 26),

Nam does not disclose a *judging* or categorizing step as claimed in the limitations below; however Cohn, as shown, does:

- *judging whether the keyword is an interested field of the user on the basis of the searched reference information* (see at least Figure 4, Items 120 and 160, categorize the address pointer, this invention determined the keywords based on the url a user requests from the browser),
- *generating an advertisement file including the keyword judged as the interested field of the user* (see at least Figure 4, Item 180),
- *updating the information for the number of advertisement files in the advertisement list information stored in the keyword database* (see at least Figure 4, Items 150 and 170, the invention determines if keywords from the address pointer or ad information have been categorized and if not updates the system to categorize them),
- *generating advertisement information including the keyword and the updated advertisement list information* (see at Figure 4, Item 180),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the categorizing method of targeting advertisements of Cohn with the advertising methods of Nam because Nam teaches selecting advertisements “depending on user’s fields of interest and the characteristics of a web page” (Abstract). Further it would have been obvious to one having ordinary skill in the art at the time the

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invention was made since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the event is one among a keyword input at a search window of an Internet search engine by the user, web page information input at an address window of a web browser by the user, and a hypertext markup language selectively input on the web browser by the user (see at least page 3, line 12, inputting a website address).*

Claim 3:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the type information is predetermined effective period information set in advance for each keyword (see at least page 16, lines 18-20).*

Claim 4:

The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the reference information is the number of times the event is input from the user during the effective period (see at least page 16, line 20-21).*

Claim 5:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement file is a cookie file (see at least page 12, line 20-21).*

Claim 6:

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The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement file includes more than one among a terminal number (PC ID) of the user, an identifying symbol of the user, expiration data information of the advertisement file (see at least page 17, lines 5-8, identifying information of the user is stored).*

Claim 20:

The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement information additionally includes the number of impressions of a web page that corresponds to the keyword (see at least page 16, line 20-21).*

Claim 7:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement information additionally includes the number of impressions of a web page that corresponds to the keyword (see at least page 16, line 20-21).*

Claim 9:

Nam discloses the limitations as shown in the rejection above. Further Nam discloses the following limitations:

- *if there is no advertisement information that corresponds to the advertisement keyword, recording, in a predetermined storing means, the received advertisement keyword and an input counter value with respect to the advertisement keyword (see at least page 3, line 20),*
- *if an advertisement request including the advertisement keyword is received from a second sponsor, increasing the input counter value with respect to the*

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advertisement keyword recorded in the storing means (see at least page 13, line 20-21),

- *if the input counter value is more than a predetermined value, recording, in the keyword database, the advertisement keyword and advertisement information that corresponds to the advertisement keyword (see at least page 3, line 20),*

Nam does not disclose the following limitations; however, Cohn, as shown, does:

- *judging whether the input counter value is more than a predetermined value information (see at least Figure 4, Items 120 and 160, categorize the address pointer, this invention determined the keywords based on the url a user requests from the browser),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02/07030 A1) in view of **Official Notice**.

Claim 11:

Nam, as shown, discloses the limitations in the rejection above. Nam does not disclose the following limitation; however, Examiner takes **Official Notice** that it is old and well known in the art to transfer payment information to a service provider.

- *the confirmation response additionally includes payment information for a predetermined advertisement charge*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include in an advertising method the ability for the advertiser to pay the

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service provider for the advertising because the service providers generally require compensation.

26. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02/07030 A1) in view of Cheung et al. (US 7,043,471 B2).

Claim 12:

Nam, as shown, discloses the following limitations:

- *the advertisement request is performed in a manner of auction or bidding*
(see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through-costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

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Conclusion

- 27.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
- 28.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 29.** Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

- 30.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/Examiner, Art Unit 4143

22 April 2008

/James A. Reagan/

Supervisory Patent Examiner, Art Unit 4143